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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/302,239      | 04/29/1999  | GARY L. NELSESTUEN   | 09531/005001        | 6644             |

7590

06/18/2002

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EXAMINER

SCHNIZER, HOLLY G

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 06/18/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

FILE

Application No.  
09/302,239

Applicant(s)

NELSESTUEN, GARY L.

Examiner

Holly Schnizer

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of the Claims***

The Amendment filed April 12, 2002 has been entered and considered. Claims 1 and 3-22 are pending. Claims 15 and 18-22 are withdrawn from consideration as being drawn to a non-elected invention. Claims 1, 3-14, 16, and 17 will be examined on the merits in this Office Action.

### ***Information Disclosure Statement***

The references AG and AH supplied with the Amendment and Response filed April 12, 2002 has been considered as noted on the copy of the 1449 attached to this Office Action.

### ***Rejections Withdrawn***

The rejection of Claims 1, 2-14, 16, and 17 under 35 U.S.C. 112, first paragraph regarding the lack of possession for the claims is withdrawn in light of applicant's arguments.

The rejection of Claims 1, 3-14, 16, and 17 under 35 U.S.C. 112, first paragraph regarding lack of enablement for the claims is withdrawn in light of applicants arguments and the amendments to the claims.

### ***Rejections Maintained***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-14, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response to the rejection for indefiniteness given in the previous Office action, Applicants have amended the claims to include sequence identifiers. However, the claims still contain substitutions at specific residues without referring to a sequence. For example, the recitation of "said modified GLA domain comprising at least one amino acid substitution at residue 11 or 29 (residue 10 or 28 of SEQ ID NO: 3 or SEQ ID NO:4, respectively)" is confusing. Is this intended to mean that the substitution of residues 11 and 29 are relative to the sequence of SEQ ID NO:3 and substitutions of residues 10 or 28 is relative to the sequence of SEQ ID NO:4? Or, is this recitation intended to mean that the substitution of residues 10 or 28 are relative to either SEQ ID NO:3 or 4? If the latter is the case, then the claim is unclear as to the context of the sequence containing substitutions residues 11 and 29. The claim would be much clearer if this last phrase recited, for example, "said modified GLA domain comprising at least one amino acid substitution at residue 10 or 28 of SEQ ID NO:3". Or, another phrase referring to only one set of residues and one sequence identifier. Likewise, Claims 7, 9, 10, and 11 should refer to a sequence identifier to place

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into context the substitution of residue 33. (Residue 33 of what sequence?)

Claims 3-6, 8, 12-14, 16 and 17 are indefinite since they depend from indefinite base claims but do not correct the deficiencies. Correction is required.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No Claims are allowable.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is

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(703) 305-3722. The examiner can normally be reached on Mon. & Thurs., 8am-5:30pm and Tues. & Wed. 9-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Holly Schnizer  
June 17, 2002



CHRISTOPHER S. F. LOW  
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